

Applicant : William A. Allen  
Serial No. : 09/312,916  
Filed : May 17, 1999  
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Attorney's Docket No.: 02103-355001 / AABOSSO6

Amendments to the Drawings:

Application owner requests the attached replacement sheets of formal drawings be substituted for all of the informal drawings currently on file in the above-identified application.

REMARKS

Claims 7, 17, 24, 35, and 37-40 have been amended to overcome formal objections without narrowing the claims.

The office action states:

1. Applicant's election with traverse of claims 1 -26 and 33-40 in the reply filed on 11/2/04 is acknowledged. The traversal is on the ground(s) that the restriction is not deemed proper. This is not found persuasive because the inventions were drawn to different processing techniques for audio in respect the various characteristics of the audio signals.

The requirement is still deemed proper and is therefore made FINAL.

Even though, the applicant elected claim 33, it will not be examined because claim 33 depends upon claim 27, which was not elected. P.2.

Withdrawal of the requirement for restriction is again respectfully requested. The office action did not deal with the authorities or reasoning set forth in the response we filed on 2 November 2004.

There we observed inter alia, that search and examination of the entire application could be made without serious burden because prior art related to the 34 Group II claims are likely to disclose subject matter related to the remaining 11 claims 27-32 and 41-45. Claims 32 and 35 call for determining whether the audio signal is surround encoded, and claim 25 calls for detecting the number of surround channels in the audio signal. It is true that the withdrawn claims do call for determining whether the audio signal has been equalized for a large room, but that involves little additional search that is unlikely to uncover art supporting rejecting these claims with this feature. Accordingly, withdrawal of the requirement for restriction is respectfully requested.

2. Claim 7, 17, 24, 35, 38 and 40 were objected to because periods should be placed at the end of the sentence in each claim. These claims have been amended accordingly.

3,4. The office action states:

4. Claims 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 37-40 recites the broad recitation, and the claim also recites a limitation which is the narrower statement of the range/limitation (see justification below).

Regarding independent claims 37 and 39, recites, "... determining whether said audio signal is an analog signal or digital signal and for determining the number and directional designators of digital signal". The claim language initially indicates the capability of processing either analog or digital signals, yet within the same limitation, the claim language is directed exclusively to processing digital signals. Thus, for the purpose of examination, the claims are indefinite.

Claims 38, and 40 are dependent upon claims 37 and 39, and thus are rejected accordingly. Pp. 2-3.

Claims 37-40 have been amended to overcome these objections. Thus the claims call for the audio signal having at least one directional input channel with the input characteristics determiner for determining the number and directional designators of the directional input channels. The claim language indicates the capability of processing either analog or digital signals while omitting any language indicating that it is directed exclusively to processing digital signals.

Accordingly, withdrawal of the rejection of claims 37-40 as indefinite is respectfully requested.

5. The allowability of claims 1-26 and 34-36 is noted.

There may be other reasons that support the allowability of the claims in addition to the statement of reasons advanced by the Examiner.

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In view of the foregoing amendments, remarks, authorities of record and the absence of prior art that anticipates, suggests or makes obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, she is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps she believes are necessary to place the application in a condition for allowance.

Please apply any other charges or credits to deposit account 06-1050, Order No. 02103-355001.

Respectfully submitted,  
FISH & RICHARDSON P.C.

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